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Supreme Court of the United States

OCTOBER TERM, 1944

No. 970

CONDENSER CORPORATION OF AMERICA,

Petitioner-Plaintiff,

v.

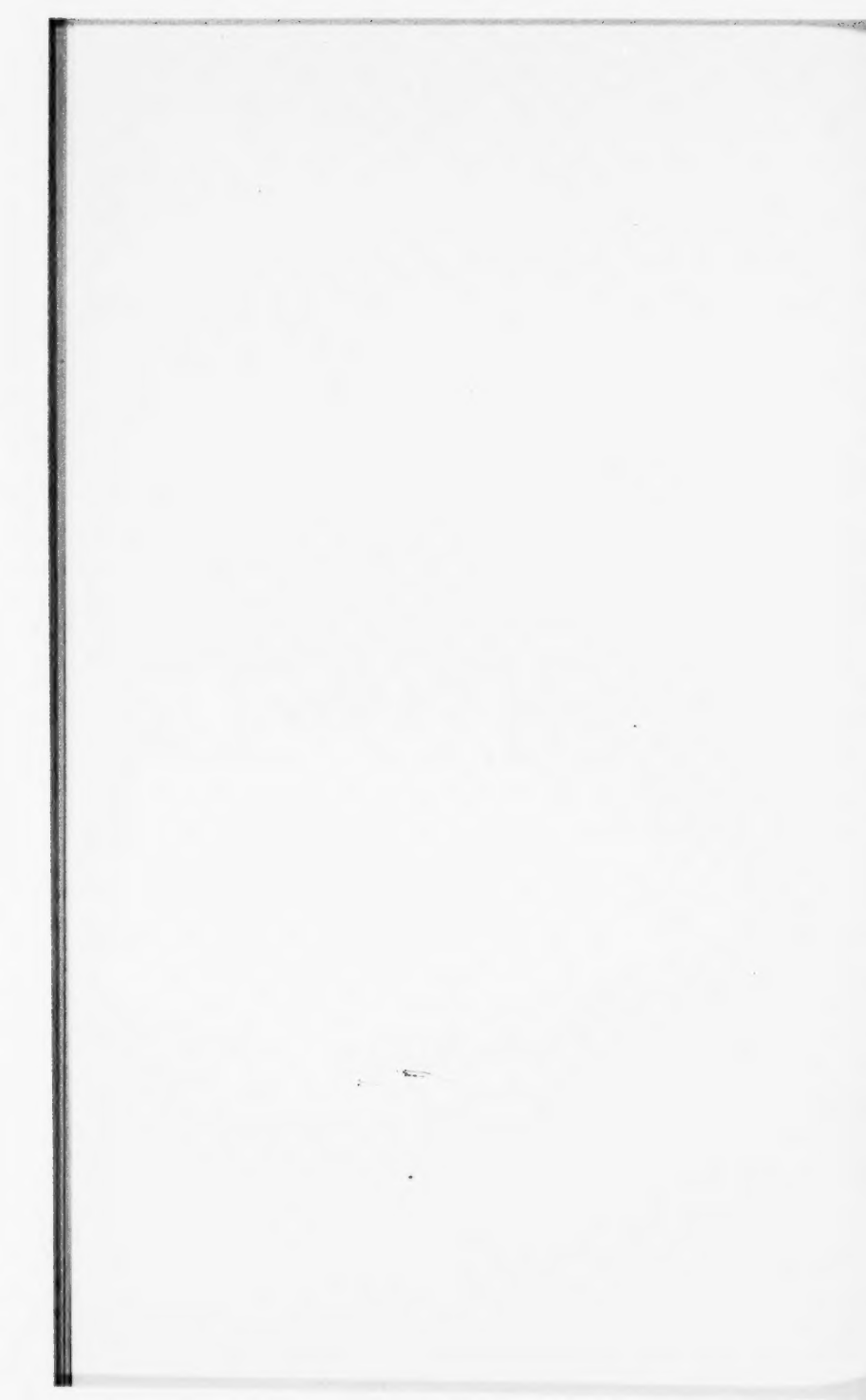
MICAMOLD RADIO CORPORATION,

Respondent-Defendant.

On Petition for Writ of Certiorari to the Circuit Court
of Appeals for the Second Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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Opinions Below

The District Court's opinion (R. 194) is reported at 54 Fed. Supp. 327. The opinion of the Circuit Court of Appeals (R. p. 440) is reported at 145 Fed. 2nd 878.

Jurisdiction

Petitioner invokes the jurisdiction of this Court under Title 28 U. S. C. Sec. 347.

Questions Presented

This is an ordinary patent infringement suit, in which the Circuit Court of Appeals directed dismissal of the complaint on the ground that the Claims 1 to 3 of the patent in question are invalid, and that Claims 9 to 12 of such patent are not infringed by respondent's accused machine.

There has been no divergence of decision between different Circuit Courts of Appeal in respect to the Danziger Patent No. 1,940,847 here involved, but petitioner contends that in holding Claims 1 to 3 of said patent to be invalid, the Circuit Court of Appeals misinterpreted or failed to follow this Court's decision in *Goodyear Tire & Rubber Co. v. Ray-o-Vac*, 321 U. S. 275, and that the holding of non-infringement of Claims 9 to 12 was rendered despite proof that the accused machines were operated in an infringing manner for at least part of the time. Petitioner also contends that in reversing the District Court's decree the Circuit Court of Appeals failed to accord due weight to the Lower Court's fact findings on matters as to which the evidence is conflicting.

It is respondent's position (1) that the decision of the Circuit Court of Appeals is not in conflict with decisions of this Court, but merely weighed the particular facts involved in this case and applied well settled principles thereto, to find invention wanting in Claims 1 to 3 and non-infringement of Claims 9 to 12; (2) that there is in no substantial sense, conflicting evidence as to the facts upon which the judgment of the Circuit Court of Appeals was founded; (3) that the decision is of no general significance (beyond correctly weighing and adjudicating the particular facts involved) and consequently that none of the recognized grounds for favorable action upon the petition have been made to appear.

STATEMENT

(a) As to Claims 1 to 3

The mechanical matters involved are well set forth in the opinion of Circuit Judge Learned Hand, at R. 440-2, from which it will be gathered that the sequence of the paper and foil cutting operations set forth in Claims 1 to 3 of the Danziger patent is the same as in the prior art; and that Danziger's alleged point of novelty is (broadly and irrespective of any particular means employed) in mechanically interconnecting the two cutters so that one will operate before the other, instead of relying on manual manipulation by the operator to secure the same sequence of operation.

(b) As to Claims 9 to 12

Judge Hand's opinion covers this phase of the case at R. 443-4 from which it will be noted that the infringement issue centered about the question of whether the accused machine has the "means for momentarily increasing the tension of the strip" at the time of cut, to which feature the claims under discussion are limited. Judge Hand discussed the evidence on the point, pointing out that in the operation of the accused machine "none but the larger condensers ever do become large enough" (R. 443) to permit any such increase in tension, and concluding that if this extra tension ever happens in the accused machine it is "of too trifling importance" and "obviously so useless in function" as not to "justify the intervention of a court" (R. 444). The above fact findings do not conflict with any concrete finding of the District Judge, whose decree of infringement was entered *without* any finding that this tension increasing feature is ever present in the accused machine to any *appreciable* or *useful* extent. And the findings of the Circuit Court of Appeals on the point were rendered on the testimony of the *petitioner's own* expert witness which appears at R. 81-85, without any conflicting evidence.

ARGUMENT

(a) As to Claims 1 to 3

As Judge Hand noted in the Court of Appeals opinion, Claim 1 alone need be considered (R. 440) and it is "a highly generalized statement" (R. 441) of the idea of mechanically securing the operation of the cutters in the desired order, instead of so doing by hand. The kernel of the Court of Appeals' opinion is to be found in the statement that it

"would be a gratuitous assumption that manufacturers, having learned from Siemens how to make condensers automatically, and how to secure an overlap of the paper strips (fol. 445) at the ends by manually cutting the foil earlier than the paper, had been obliged to wait twenty years for the notion alone that it would be desirable to gear the cutter in phase with the 'arbor'. Had it been the mechanical difficulties which baffled them, the delay might have been evidence of some invention; but that invention would have lain in contriving the solution, not in the discovery that a solution was desirable; which is all that the defendant can on any theory be thought to have borrowed from Danziger" (R. 443).

In other words, the petitioner is seeking to sustain a broad and abstract monopoly to the timing of operation of the cutters mechanically instead of by hand, and Judge Hand's disposition of this contention is unanswerably sound. If it be assumed, as petitioner contends, that there were difficulties in mechanizing the cutting operations which baffled those skilled in the art, then any invention arising out of the solution of these difficulties would necessarily lie in the *particular means* provided to overcome them, and no claim such as petitioner is making to mechanization in the abstract, would be justified (*Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, at p. 257). Furthermore such an assumption of genius needed to mechanize the cutting operations, flies directly in the face of the evidence of peti-

tioner's own expert who testified that given the idea of "the sequential operation of cutting the foil and paper," an engineer

"could have assembled these shafts and rollers and other parts to carry out that inventive concept. I attach considerable importance to Mr. Danziger's inventive idea of the sequence in which he was going to carry out these operations, and not too much importance to the mechanical details of carrying it out. I think they could be varied within very wide limits" (R. p. 89).

Beyond question, the "sequence" was in the prior art, and there was no evidence that those skilled in the art had been trying for years to mechanize these cutting operations and had been unable to do so. Thus the Court of Appeals in reaching its decision applied no new or unusual legal principles; the Court merely weighed the evidence and found that under the facts petitioner's case on invention does not measure up to the standards of the cases relied on in the petition.

(b) As to Claims 9 to 12

As already noted, *supra*, p. 3, the Court of Appeals' holding of non-infringement is predicated upon a finding that the tension increasing feature of these claims never appears in defendant's machine to any appreciable or useful extent, and this finding was made with neither substantial evidence nor any finding of the Lower Court to the contrary. The District Court simply overlooked the point, as the same District Judge had previously done in a case against the same defendant which was reversed by the same Circuit Court of Appeals on the same grounds (*Aerovox Corp. v. Micamold Radio Corporation* (C. C. A. 2), 92 Fed. 2nd 45, 46. Patents being limited by Statute to *useful* features (Title 35 U. S. C. Sec. 31), we do not think it is necessary to labor the point that a machine should not be

held to infringe under circumstances where a claimed feature never appears therein to any appreciable or useful extent.

Conclusion

The decision below is correct. The questions presented involve only the application of well settled rules of law to facts peculiar to this case and are not of general importance, nor worthy of review in this Court.

Respectfully submitted,

KENNETH S. NEAL.
Counsel for Respondent.

Dated, March 1945.

